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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/004,836 | 12/07/2001 | Yves Audebert | L741.01111 | 7843 |

7590 11/01/2005

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EXAMINER

LEMMA, SAMSON B

ART UNIT

PAPER NUMBER

2132

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/004,836 | AUDEBERT ET AL. |
| | Examiner Samson B. Lemma | Art Unit 2132 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 07 December 2001.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-40 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) 29-40 is/are allowed.
 6) Claim(s) 1-3,15-18,27 and 28 is/are rejected.
 7) Claim(s) 4-14 and 19-26 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>4,5 & 6</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. **Claim 1-40** have been examined.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-3 and 15-18 and 27-28** is rejected under 35 U.S.C. 102(e) as being anticipated by Lee et al (hereinafter referred as Lee) (U.S. Patent No 6,367011)

4. **As per claim 1-3, Lee discloses a data processing system for initially generating and installing at least one personal security device PSD master key replacement key and at least one PSD master key inside at least one PSD, said system comprising:**

- **A first server including data storage means,[Figure 1, ref. Num “154”] (column 5, line 51-53] wherein**
- **Said first server [figure 1, ref. Num “154”] is functionally connected to a first hardware security module HSM [figure 1, ref. Num “130”] and a PSD writer [figure 1, ref. Num “150”];**

- Said PSD writer [figure 1, ref. Num "150"] functionally connected to said first server [figure 1, ref. Num "154"] and said at least one PSD; [figure 1, ref. Num "180"]
- Said at least one PSD including a non-mutable unique identification number [column 4, lines 55- 65 and column 7, lines 55-column 8, line 3],
 - A security executive, a first high level key slot and a second high level key slot, wherein said PSD is functionally connected to said PSD writer; [Figure 1, ref. Num "180" & ref. Num "150"]
 - Said first HSM including at least one stored public key, at least one stored master key data block, at least one stored master key replacement key data block and means for generating random numbers,[column 6, lines 11-15] wherein said first HSM [figure 1, ref. Num "130"] is functionally connected to said first server [figure 1, ref. Num "154"]

5. As per claim 15-18 and 27-28, Lee discloses a data processing system for post issuance master key replacement for at least one personal security device PSD, said system comprising:

- A client functionally connected to said at least one PSD/smart card [column 4, lines 39-42] and in secure communications with a first server [figure 1, ref. Num "154"; Column 6, lines 27-28]; Said at least one PSD including a non-mutable unique identification number, a pre-installed key replacement key, an active master key and a security executive [column 7, lines 55-column 8, lines 3],

wherein said PSD/smart card [figure 1, ref. Num “180”] is functionally connected to said client [column 4, lines 39-42];

- **A first server [figure 1, ref. Num “154”] including at least one stored unique cryptogram associated with said non-mutable unique identification number,[figure 1, ref. Num “159” and column 8, lines 59-62]**
- **Wherein said first server [Figure 1, ref. Num “154”] is functionally connected to a first hardware security module HSM [figure 1, ref. Num “130”] and in secure communications with said client;[figure 4, lines 39-42]**
- **A second server [figure 1, ref. Num “150”] functionally connected to a second HSM [figure 1, ref. Num “152”];**
- **Said first HSM [Figure 1, ref. Num “130”] including cryptography means, key generation and key transfer means [column 6, lines 11-15],**
- **Wherein said first HSM [figure 1, ref. Num “130”] is functionally connected to said first server [figure 1, ref. Num “154”];**
- **Said second HSM [figure 1, ref. Num “152”] including cryptography means, a master key replacement key data block, a master key data block, key generation and key transfer means, at least one stored private key, [column 6, lines 18] (as explained on column 6, line 18, the second HSM is similar/having the similar features with first HSM shown on figure 1, ref. Num “130”]**
- **Wherein said second HSM [Figure 1, ref. Num “152”] is functionally connected to said second server [figure 1, ref. Num “152”]**

Allowable Subject Matter

6. **Independent Claims 29 and 35** are allowed.
7. **The dependent claims 30-34 and 36-40**, being further limiting to the independent claims **29 and 35** respectively, definite and enabled by the specification are also allowed.
8. **Claims 4-14 and 19-26** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.(See PTO-Form 892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samson B Lemma whose telephone number is 571-272-3806. The examiner can normally be reached on Monday-Friday (8:00 am---4: 30 pm). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BARRON JR GILBERTO can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SAMSON LEMMA

S..L.

10/18/2005

Gilberto Barron Jr.

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